

### REMARKS/ARGUMENTS

Claims 11 and 13-16 stand rejected under 35 USC 112, second paragraph, as being indefinite for reciting that the membrane contains functional groups "capable of" chemically coupling with protease inhibitors. In response, claim 11 has been amended so as to affirmatively recite that the functional groups are chemically coupled to at least one protease inhibitor selected from those recited in claim 11. Since claims 13-16 all ultimately depend from claim 11, the Section 112 rejection is submitted to be overcome.

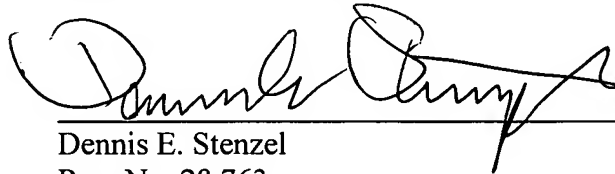
Claims 11 and 13-15 stand rejected under 35 USC 103(a) as being unpatentable over Grano in view of the '238 and '041 patents for the reasons previously made of record by the Examiner. In response, applicants repeat and incorporate herein by reference the arguments set out at pages 4-6 of the Amendment dated July 13, 2007.

Claims 11, 13 and 16 stand rejected under 35 USC 103(a) as being unpatentable over the newly cited Charcosset Review entitled "Purification of Proteins by Membrane Chromatography." The Examiner's reasoning appears to be that, since Charcosset lists in Table I the Sartobind<sup>®</sup> epoxy-functionalized membrane used in Examples 1 and 2 of the instant application, Charcosset necessarily discloses membranes "capable of" chemically coupling with inhibitors of acid proteases, metalloproteases, cysteine proteases and serine proteases. But in order to reach this conclusion, the Examiner has used applicants' own teaching in the instant specification that such epoxy-functionalized membranes can chemically couple with such protease inhibitors. Evidently the Examiner is unaware that such hindsight reconstruction of the claimed invention by using an applicant's own teaching is impermissible under U.S. patent law. See *In re McLaughlin*, 170 USPQ 209, 212 (CCPA 1971) and MPEP 2145.X.A. In any event, the only independent claim in the application, claim 11, has been amended to remove the

"capable of" language and to affirmatively recite that the functionalized membrane is coupled to at least one protease inhibitor of the types listed in claim 11. Since Charcosset does not disclose or suggest that the Sartobind<sup>®</sup> membrane is coupled to any protease inhibitor, let alone any of the four classes of protease inhibitors recited in claim 11, that claim is not rendered obvious by Charcosset. Since claims 13 and 16 both depend from claim 11 and so necessarily incorporate the same limitations, there is likewise no proper obviousness rejection of claims 13 and 16.

For the reasons stated, early and favorable reconsideration is respectfully solicited.

Respectfully submitted,



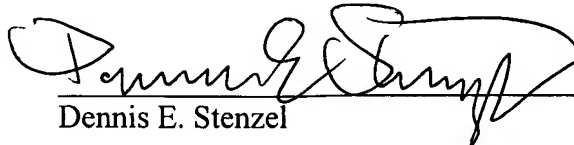
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#### CERTIFICATE OF MAILING

I hereby certify that this AMENDMENT is being deposited with the United States Postal Service as first class mail on the date indicated below in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date

2/27/08



Dennis E. Stenzel